Supreme Court, U.S.
FILED
AUG 2001
OFFICE OF THE CLERK

No. 01-35

IN THE

Supreme Court of the United States

SENIOR TECHNOLOGIES, INC.,

Petitioner,

v.

R.F. TECHNOLOGIES, INC.,

Respondent.

On Petition For Writ of Certiorari
To The U.S. Court of Appeals for the Federal Circuit

PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION

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PARTIES TO THE PROCEEDING

Petitioner: Senior Technologies, Inc.

Petitioner's Corporate Disclosure Statement:

> Senior Technologies, Inc. has no parent company and has issued no shares to the public.

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NEW POINTS PRESENTED IN BRIEF IN OPPOSITION

The Respondent's brief in opposition rewords the three questions presented to the Court in the Petitioner's petition into four questions with entirely different meaning. The first question presented by the Petitioner is related to the propriety of construing claim 1 to include a limitation of a "housing", namely:

> "1. Under what circumstances is it proper for the Court to construe a claim to include a limitation not directly recited in the claim?"
>
> (Petition for Writ of Certiorari, page i)

The second and third questions presented in the Petitioner's petition for writ of certiorari relate to the application of the doctrine of equivalents, namely:

> "2. Does an amendment to a claim that only repeats a limitation for clarity create file wrapper estoppel that prevents the doctrine of equivalents from being applied to the limitation under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999)?
>
> 3. May a limitation that was construed to be in a claim but is not necessary to understand any other term in the claim be

> expanded under the doctrine of equivalents?"
>
> (Petition for Writ of Certiorari, page i).

The four new or reworded questions proposed by the Respondent include three questions related to construing a claim to contain an element not directly recited, questions 1, 3 and 4, and one question related to the doctrine of equivalents, question 2.

Questions 1, 3 and 4 in the Respondent's brief are:

> "1. Did the Federal Circuit correctly interpret the claim element "module" to be a "housing," using the language in Claim 1 and the specification and drawings?
>
> 3. Under the doctrine of claim differentiation, did the Federal Circuit properly construe an independent claim to not include an element contained in a dependent claim?
>
> 4. Under the doctrine of equivalent's corollary to the "all limitations" rule, did the Federal Circuit correctly conclude that Claim 1 does not embrace a "sensing means" outside of the housing or module in which the receiving circuit is located?"
>
> (Respondent's Brief in Opposition, page i)

Firstly, the fourth question is properly a limitation on the manner of applying the doctrine of equivalents and isn't applicable to the question in this case of whether the limitations construed by the Court to be in claim 1 are properly considered in claim 1. The third question also seems misplaced since it does not address the limitations in question, namely, is claim 1 limited by a single housing within which lies the receiving circuit which is the limitation the Court of Appeals for the Federal Circuit construed to be in claim 1 when it held:

> "We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us.....
>
> Another issue before the district court was whether the '155 patent disclosed a limitation of a single housing within which lies the receiving circuit. As a matter of law, we conclude that both claims 1 and 6 do include such a limitation."
>
> (Appendix A, page 10, beginning with the second paragraph)

The Court of Appeals clearly did construe a single housing in which lies the receiving circuit into claim 1, although it is not recited.

The Petitioner's position is still correct because neither the doctrine of claim differentiation nor the "all

limitations" rule authorize the construction of an element from the specification into a claim.

The second question in the Respondent's brief is:

> "2. Under this Court's decision in *Warner-Jenkinson Co. v. Hilton Davis Co.*, 520 U.S. 17 (1997), does file wrapper estoppel arise when the patentee offers the Federal Circuit no explanation for a claim amendment?"
>
> (Respondent's Brief in Opposition, page i)

This question seems inappropriate since the Court of Appeals in its new ground for affirming the decision below does not rely on file wrapper estoppel, but the Court of Appeals expressly recognized that a reason was given for the amendment to claim 1.

The Court of Appeals for the Federal Circuit states in its decision of March 12, 2001:

> "Furthermore, the prosecution history reveals that, in order "to clarify ambiguities," claim 1 was amended such that "the receiving circuit" would be specifically located "in the sensing module." Hence, the claim language, specification, and prosecution history all indicate that the receiving circuit must be contained within the housing of the sensing module."
>
> (Appendix A, page 11, lines 10-17)

There is no discussion in this section of whether the amendment related to patentability or not. The ambiguity related to a slight difference in the language of a similar recitation earlier in the original claim filed before the United States Patent and Trademark Office and a second related recitation.

The *Warner-Jenkinson* case does not require the explanation for an amendment to be in a brief on appeal but requires it to be established by the applicant. This was done in the file wrapper history with the amendment that it explains. That condition is satisfied here as pointed out by the Court of Appeals for the Federal Circuit. The amendment was made to cure ambiguities (Appendix A, page 11, lines 10-17). The nature of those ambiguities are clear from the claim and the arguments in the amendment.

The District Court referred to that quotation as did the Court of Appeals for the Federal Circuit but only the District Court held there was file wrapper estoppel because of it. The District Court held file wrapper estoppel under *Festo (supra)* and *Athletic (supra)* under which decisions it made no difference what reasons were given in the file wrapper (Appendix A, page 13, last paragraph, to page 14, first paragraph, and page 16, second paragraph). The ambiguity in the file wrapper was a slight deviation in the language in which the location of the sensing module was described in two places. It was not made in response to a prior art rejection and raised no issue of substance.

The ambiguity was cured by using the same language in both places without changing any meaning or adding any limitation. The original claim as

submitted included the limitation "sensing module including a receiving circuit" in the fourth paragraph but in the fifth paragraph it was recited as "receiving circuit" (Joint Appendix before Court of Appeals, page A001362). The amendment was to change the recitation in the fifth paragraph from "response to the opening of the door" to "means to enable the receiving circuit in the sensing module" rather than merely the receiving circuit and thus made it correspond to the recitation in the fourth paragraph stating that the sensing module includes the receiving circuit (Joint Appendix before Court of Appeals, page A001382). This was clearly not a matter of substance but the curing of an ambiguity and was argued as such (Joint Appendix before Court of Appeals, page A001384).

The position of the Court of Appeals for the Federal Circuit was that it was an amendment and it was unnecessary to look further because of the holding that the doctrine of equivalents can not be applied under *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996) and *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 187 F.3d 1381, 51 USPQ2d 1959 (Fed. Cir. 1999).

In addition to rewording the questions, the Respondent's brief in opposition presents two new points discussed below.

1. Did the Court of Appeals reverse the District Court's decision of noninfringement but find alternative grounds for affirming, which alternative grounds are the subject of this petition (Respondent's Brief in Opposition, page 4, lines 6-12)?

The Court of Appeals for the Federal Circuit addressed what it characterized as the main issue of the Appellant (Appendix A, page 8, first full paragraph). The question of the interpretation of claim 1 was considered and whether there was error on the part of the Court of Appeals for the Federal Circuit in reading language from the specification into the claim. The Appellant's position in its brief on appeal is that without such an improper reading of a limitation into claim 1, there would be literal infringement (Appellant's Brief of January 21, 2000, Statement of Issues (b) and (d), page 3).

It appears that the Court of Appeals for the Federal Circuit agreed with the Appellant that there would be literal infringement. The Court of Appeals for the Federal Circuit in rendering its decision stated:

> "Therefore, the district court erred by not including the microprocessor in its comparison of the accused device with the construed "receiving circuit." When the functions of the microprocessor are properly understood, and the claim is read on those functions, the presence of the microprocessor in the accused device provides no ground for noninfringement of the claims.
>
> We must, however, also determine whether the district court's conclusion of noninfringement can be affirmed on alternative grounds present in the record before us."
>
> (Appendix A, page 9, last line, through page 10, line 10).

Clearly the Court believed that its reversal of the interpretation of the accused device resulted in infringement. Why else would it refer to alternative grounds and continue its following discussion without affirming a specific holding of the District Court. Instead, it re-analyzed the claims, clearly stating "Having properly construed claims 1 and 6 to require a single housing within which lies a receiving circuit..." (Appendix A, page 13, lines 3-4). In making its holding, the Court states "Moreover, the same passage from the specification mentioned above confirms this interpretation in that the "switch 168 is connected by leads 170 and 172 to a housing 174 in which the receiv[ing] circuit is located." (Appendix A, page 11, lines 23-26).

Petitioner's position is that the mere holding that the receiving circuit must be in the sensing module would not preclude infringement since the word "module" does not by itself necessarily imply anything about how closely together the components of the module must be packed but instead is a functional term as shown by the manner in which it is used in the claim, e.g. transmitting module and sensing module.

Claim 1 not only does not recite "housing", it doesn't recite the sensing module and receiving means in a single housing. It does not recite anything about the location of the components of the sensing module but only what at least some of those components are.

2. Has the Petitioner waived its right to argue error in applying *Festo (supra)* and *Athletic (supra)* in

the Court of Appeals' alternative grounds for affirming the court below (Respondent's Brief in Opposition, page 8, lines 13-19)?

It was unnecessary to avoid a waiver for the Petitioner to more specifically argue the interpretation of the claims other than to point out, as it did, that limitations were improperly read into the claims. Its position was there was literal infringement of claim 1.

The alternative grounds for affirming the court below, by interpreting claim 1 as including a housing in which the sensing module and the receiving circuit were located, raises the question of file wrapper estoppel.

It is the Petitioner's position that the Court of Appeals improperly construed claim 1 to include limitations not recited in it to affirm the District Court's holding of no literal infringement and then to rely upon *Festo (supra)* and *Athletic (supra)* to preclude infringement under the doctrine of equivalents.

CONCLUSION

The three questions presented by the Petitioner are significant matters of concern to the businesses that wish to produce new products because these questions relate to the decisions made by manufacturers concerning what they are entitled to manufacture and what is covered by another's patent rights and on the other hand, whether the rights available to an inventor under the patent system are worth the cost of development. A decision on the questions presented in

the Petitioner's petition will increase the certainty with which such questions can be answered.

Respectfully submitted,

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